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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,801	02/09/2004	Yves Leclaire	ESSR:060USD1	9054
32425	7590	11/04/2004	EXAMINER	
FULBRIGHT & JAWORSKI L.L.P. 600 CONGRESS AVE. SUITE 2400 AUSTIN, TX 78701			MARKHAM, WESLEY D	
			ART UNIT	PAPER NUMBER
			1762	

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/774,801

Applicant(s)

LECLAIRE ET AL.

Examiner

Wesley D Markham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 10/057,472.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/5/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Acknowledgement is made of the response filed by the applicant on 9/14/2004 (with a certificate of mailing dated 9/8/2004). The applicant's arguments regarding the 35 U.S.C. 112, second paragraph, rejection of Claims 20 – 26 are persuasive, and the aforementioned rejection is withdrawn. **Claims 20 – 26** remain pending in U.S. Application Serial No. 10/774,801, and an Office Action on the merits follows.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy of French Application 01/01028 (filed on 1/25/2001) has been filed in parent Application No. 10/057,472, filed on 1/25/2002.

Information Disclosure Statement

3. The IDS filed by the applicant on 4/5/2004 is acknowledged, and the references listed thereon have been considered by the examiner as indicated on the attached copy of the PTO-1449 form.

Drawings

4. The drawings are objected to because only a single view (i.e., the drawing labeled as FIGURE 1) is used to illustrate the claimed invention, and when only a single view is utilized, it must not be numbered and the abbreviation "FIG." must not appear (37 CFR 1.84(u)(1)). The applicant is suggested to amend the "FIGURE 1" label in the drawing and to amend the specification accordingly (i.e., so that the specification

refers to "the figure" instead of "Fig. 1"). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. Also, the examiner

notes that the abstract primarily discusses a method, while the claims of the instant application are drawn to a product (i.e., an ophthalmic lens).

6. The use of the trademark ORMA has been noted in this application (see page 7, line 17, of the specification). It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

7. Claims 21 – 26 are objected to because of the following informalities: The word, "ophthalmic" is misspelled, "opthalmic". Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 23 – 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
10. **Claims 23 – 25** recite the limitation "the additive". There is insufficient antecedent basis for this limitation in the claims. Specifically, Claims 23 – 25 all depend from

independent Claim 20 and refer to "the additive". However, Claim 20 does not recite or require an "additive". As such, it is unclear to what "the additive" in Claims 23 – 25 refers, and the scope of the claims is vague and indefinite.

Claim Observations

11. Regarding Claims 21, 24, and 26, the examiner has reasonably interpreted the features associated with the term "preferably" in each of the claims to be exemplary, not limiting.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

13. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

14. Claims 20, 21, and 23 – 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Chen et al. (USPN 6,551,710 B1).

15. Regarding independent **Claim 20**, Chen et al. teaches an ophthalmic lens comprising an optically transparent substrate (Abstract, Col.1, lines 3 – 12), wherein the substrate is coated, on at least one face, with an optically transparent impregnatable thin film adhering to the substrate (Col.2, lines 1 – 19 and 37 – 67, Col.3, lines 1 – 48, Col.25, lines 25 – 67, Cols.26 – 28, and Col.29, lines 12 – 14 and 40 – 43) and comprising an “impregnation composition” (Col.2, lines 13 – 19, Col.3, lines 1 – 4 and 25 – 33, Col.20, lines 38 – 50, Col.28, lines 15 – 37). Chen et al. also teaches that the impregnatable thin film is produced from a polymer material (**Claim 21**) (Col.2, lines 1 – 13, and Cols.4 – 19, which show the components of the “polymer material”); the impregnation composition is a solution or dispersion, in a diluent medium, of an additive (e.g., a photochromic dye) to be incorporated (**Claims 23 and 25**) (Col.2, lines 13 – 19, Col.3, lines 1 – 4 and 25 – 33, Col.20, lines 38 – 50, Col.28, lines 15 – 37); the impregnation composition contains an agent for retaining the additive (**Claim 24**) (Col.11, lines 51 – 60, Col.19, lines 34 – 67, Col.20, lines 1 – 37 and 59 – 67, Col.25, lines 11 – 16); and the impregnatable thin film in

which the additive (dye) is incorporated is coated with an “anti-scratch” coating
(**Claim 26**) (Col.2, lines 54 – 57, Col.26, lines 49 – 65, Col.27, lines 11 – 64, Col.28,
lines 33 – 37, and Example 17).

16. Claims 20 – 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Welch et al. (US 2002/0009599 A1).

17. Regarding independent **Claim 20**, Welch et al. teaches an ophthalmic lens comprising an optically transparent substrate (paragraphs [0005], [0066], [0068], [0077], and [0080]), wherein the substrate is coated, on at least one face, with an optically transparent impregnable thin film adhering to the substrate (Abstract, paragraphs [0007], [0010], [0032], [0067], [0074], [0075]) and comprising an “impregnation composition” (paragraphs [0058] – [0065], and the examples). Welch et al. also teaches that the impregnable thin film is produced from a polymer material, particularly a polyurethane latex (**Claims 21 and 22**) (Abstract, paragraphs [0010] – [0057]); the impregnation composition is a solution or dispersion, in a diluent medium, of an additive (e.g., a dye) to be incorporated (**Claims 23 and 25**) (paragraphs [0058] – [0064], and the examples, which clearly show that the coating composition contains a solvent / diluent medium); the impregnation composition contains an agent for retaining the additive (**Claim 24**) (paragraph [0065]); and the impregnable thin film in which the additive (dye) is incorporated is coated with an “anti-scratch” coating (**Claim 26**) (paragraphs [0006], [0071], [0072]).

18. Claims 20 – 23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Goepfert et al. (USPN 4,454,170).
19. Regarding **Claims 20 – 23 and 25**, Goepfert et al. teaches an ophthalmic lens comprising an optically transparent substrate (Col.1, lines 6 – 16, Col.3, lines 9 – 11, and Col.6, lines 48 – 51), wherein the substrate is coated, on at least one face, with an optically transparent impregnatable thin film produced from a polymer material, specifically a polyurethane latex, adhering to the substrate and comprising an impregnation composition, wherein the impregnation composition is a solution or dispersion, in a diluent medium, of an additive (i.e., a dye) to be incorporated (Abstract, Col.3, lines 51 – 68, Col.4, lines 44 – 68, Col.5, lines 1 – 43, and Col.7, lines 1 – 59).
20. Claims 20 – 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Parker et al. (USPN 5,770,259).
21. Regarding independent **Claim 20**, Parker et al. teaches an ophthalmic lens comprising an optically transparent substrate (Abstract, Figures 1 – 6, Col.1, lines 5 – 24, Col.2, lines 13 – 25), wherein the substrate is coated, on at least one face, with an optically transparent impregnatable thin film adhering to the substrate (Col.2, lines 13 – 67, Cols.3 – 4, Col.5, lines 1 – 6 and 61 – 67, Col.6, lines 1 – 3, and Cols.13 – 14) and comprising an “impregnation composition” (Col.2, lines 26 – 65, Col.3, lines 44 – 54, Col.4, lines 1 – 35, Col.5, lines 36 – 67, Col.7, lines 39 – 67, and Col.8, lines 1 – 8). Parker et al. also teaches that the impregnatable thin film is

produced from a polymer material, particularly a polyurethane latex (**Claims 21 and 22**) (Col.4, lines 11 – 35); the impregnation composition is a solution or dispersion, in a diluent medium, of an additive (e.g., a dye or a pigment) to be incorporated (**Claims 23 and 25**) (Col.2, lines 26 – 65, Col.3, lines 44 – 54, Col.4, lines 1 – 35, Col.5, lines 36 – 67, Col.7, lines 39 – 67, and Col.8, lines 1 – 8); the impregnation composition contains an agent for retaining the additive (**Claim 24**) (Col.4, lines 28 – 30); and the impregnable thin film in which the additive (dye or pigment) is incorporated is coated with an “anti-scratch” coating (**Claim 26**) (Figure 1; Col.2, lines 48 – 65, Col.5, lines 1 – 3).

22. Claims 20, 21, and 23 – 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Guest et al. (USPN 5,013,608).

23. Regarding **Claims 20, 21, and 23 – 25**, Guest et al. teaches an ophthalmic lens comprising an optically transparent substrate (Col.1, lines 8 – 18, Col.10, lines 30 – 36 and 60 – 67, and Col.11, lines 1 – 12 and 32 – 34), wherein the substrate is coated, on at least one face, with an optically transparent impregnable thin film produced from a polymer material, adhering to the substrate and comprising an impregnation composition, wherein the impregnation composition is a solution or dispersion, in a diluent medium, of an additive (i.e., a dye) to be incorporated, and wherein the composition contains a crosslinking agent (e.g., “for retaining the additive”) (Col.3, lines 8 – 61, Cols.4 – 6 (which teach the polymeric components of

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the base resin), Col.7, lines 38 – 49, Col.9, lines 59 – 68, Col.10, lines 1 – 59, and Example 2).

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

26. Claims 20 – 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farber et al. (USPN 5,316,791) in view of Parker et al. (USPN 5,770,259) and Goepfert et al. (USPN 4,454,170).

27. Regarding **Claims 20 – 26**, Farber et al. teaches an ophthalmic lens comprising an optically transparent substrate (Abstract, Col.1, lines 8 – 19), wherein the substrate

is coated, on at least one face, with an optically transparent impregnatable thin film produced from a polymer material, specifically a polyurethane latex primer, adhering to the substrate, wherein the impregnatable thin film is coated with an anti-scratch coating, preferably based on a silane hydrolysate (Abstract, Col.1, lines 8 – 14, Col.2, lines 50 – 68, Col.3, lines 1 – 50, Col.14, lines 13 – 59, Col.5, lines 28 – 57, and Example 1). Farber et al. does not explicitly teach that the polyurethane primer comprises an “impregnation composition”, specifically a solution or dispersion, in a diluent medium, of an additive (e.g., a dye) to be incorporated. However, Farber et al. does teach that the protective hard (anti-scratch) coating (i.e., the coating on top of the polyurethane latex primer) can be tinted using a tinting bath at elevated temperatures, as is known in the art (Col.4, lines 55 – 59). Parker et al. teaches that, in the art of producing coated, tinted ophthalmic lenses (i.e., a process analogous to that of Farber et al.), either (1) the primer coating on the lens can be tinted and then coated with an untinted hard coating, or (2) the primer coating on the lens can be untinted and then coated with a tinted hard coating (as taught by Farber et al.) (Col.5, lines 1 – 6). In other words, Parker et al. teaches the functional equivalence of (1) tinting the primer coating (i.e., the “impregnatable thin film”, as claimed by the applicant) and (2) tinting the hard top coating that overlies the primer coating (as taught by Farber et al.). The tinting material taught by Parker et al. comprises a solution or dispersion, in a diluent medium, of a dye (i.e., an additive) to be incorporated into the coating(s) (Col.5, lines 36 – 67, Col.7, lines 39 – 67, and Col.8, lines 1 – 8). Goepfert et al. teaches that, in the art of tinting polyurethane coatings on

ophthalmic lenses, the tinting process is typically carried out by impregnating the coating with a solution or dispersion of a dye in a diluent medium (Col.3, lines 51 – 68, Col.4, and Col.5, lines 1 – 43). It would have been obvious to one of ordinary skill in the art to impregnate the polyurethane latex primer coating of Farber et al. with an “impregnation composition” comprising a solution or dispersion of a dye in a diluent medium (so that the coating comprises the “impregnation composition”) with the reasonable expectation of (1) success, as Goepfert et al. teaches that polyurethane coatings on ophthalmic lenses can be tinted in such a manner, and (2) obtaining similar results, regardless of whether the primer coating is tinted (as taught by Parker et al. and claimed by the applicant) or the hard top-coating is tinted (as taught by Farber et al.). In other words, since Parker et al. teaches that a lens can be tinted by either tinting the top coating or tinting the primer coating and then applying an untinted top coating, it would have been obvious to one of ordinary skill in the art to utilize either method to tint a lens. Regarding Claim 24, the examiner has reasonably interpreted the acrylic emulsion(s) taught by Farber et al. (Col.4, lines 37 – 39) for blending with the polyurethane latex coating material to be “an agent for retaining the additive” (i.e., the dye), as claimed by the applicant.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Anderson et al. (USPN 6,500,486) teaches an ophthalmic lens comprising a tinted polymeric abrasion resistant coating. Krishnan et al. (USPN

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6,065,836) teaches a polycarbonate (PC) ophthalmic lens comprising (1) a polyurethane coating having a photochromic dye impregnated therein, and (2) a hard-coating over the polyurethane coating (Col.2, lines 2 – 14). Essilor (FRANCE 2 795 082 A1) teaches a spectacle lens having a dye-impregnated latex coating thereon (Abstract).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley D Markham whose telephone number is (571) 272-1422. The examiner can normally be reached on Monday - Friday, 8:00 AM to 4:30 PM.

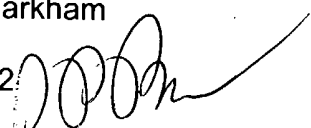
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



WDM

Wesley D Markham
Examiner
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